



ATLAS 9452 US

**IN THE
UNITED STATES
PATENT AND TRADEMARK OFFICE**

FILE COPY

IN RE APPLICATION OF: Braven, Keay, and Flower

CASE: ATLAS 9452 US

**DECLARATION UNDER
37 C.F.R. § 1.132**

SERIAL NO.: 10/562,290

FILED ON: 20 June 2006

FOR: Protease Detection Assay

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

EXAMINER: MARTIN, Paul C.

ART UNIT: 1657

DECLARATION UNDER 37 C.F.R. § 1.132

Sir,

I, John Clarkson, declare as follows:

I, Stephen Flower, declare as follows:

1. I am the CEO of Atlas Genetics, Ltd., of Trowbridge, U.K. Atlas Genetics Ltd. is the assignee of the above-referenced application for patent ('290 application) and assignee of published patent application, US 2005/0221315 A1, herein referred to as "Braven et al.".
- I am one of the named inventors on the above-referenced application for patent.

2. Dr Helen Braven and Dr Russell Keay contributed to the disclosure of Braven et al. and are named inventors of Braven et al. in compliance with 37 CFR § 1.63(a)(4) & § 1.75. The subject matter claimed in Braven et al. is drawn to compositions and methods for probing for nucleic acids. I did not contribute to the disclosure of Braven et al., nor do I claim inventorship of the subject matter as claimed in Braven et al., in compliance with 37 CFR § 1.63(a)(4) & § 1.75.
3. Dr Helen Braven, Dr Russell Keay, and Dr Stephen Flower contributed to the disclosure of the '290 application and are named inventors of the '290 application. The subject matter claimed in the '290 application is drawn to compositions and methods for detecting protease activity. I contributed to claims 1-15 and 17 - 18 in the above-referenced application for patent ('290 application) as originally filed and to pending claims 19 – 23 and 25 - 31 in compliance with 37 CFR § 1.63(a)(4) & § 1.75.
4. Dr Flower collaborated with Dr. Braven and Dr. Keay after Braven et al. was originally filed, therefore Dr. Flower could not have contributed to the disclosure of Braven et al. Dr. Flower contributed his knowledge of chemistry to the invention of Dr. Braven and Dr. Keay that resulted in his name as inventor on the '290 application. I did not collaborate with Dr. Braven and Dr. Keay until after Braven et al. was filed in the United States and so was unaware of the subject matter of Braven et al. until that collaboration began. I made contributions to the invention of Dr. Braven and Dr. Keay that resulted in the disclosure and claims of the '290 application.
5. I further conclude that the named inventors of Braven et al. are a subset of the named inventors of the '290 application and therefore the application for patent (Braven et al.) cannot be considered to have been filed by "another" as set forth in 35 U.S.C. § 102(e).

6. The Braven et al. reference therefore is not a prior art anticipating reference as defined by 35 U.S.C. § 102(a) or (e).
7. The Braven et al. reference therefore is not prior art as defined by 35 U.S.C. § 103(a).
8. I further declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.



John Clarkson, Ph.D.

Dated: July 24, 2009



Stephen Flower, Ph.D.

Dated: July 24, 2009

Assignment of Intellectual Property Rights

- (1) Ormetech plc
- (2) Molecular Sensing plc
- (3) Molecular Sensors Limited
- (4) Atlas Genetics Limited

Dated 16 September 2005

Osborne Clarke

Temple Quay
2 Temple Back East
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PQ/897149/B; 519136/ALKZ

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This Agreement is made on 16 day of September 2005

Between:

- (1) Osmetech plc (company number: 02849544) whose registered office is at c/o Ashurst Broadwalk House, 5 Abchurch Lane, London EC4A 3DF ("Osmetech");
- (2) Molecular Sensing plc (company number: 03642376) whose registered office is at 12 St. James's Square, London, SW1Y 4RB ("Molecular")
- (3) Molecular Sensors Limited (company number: 03294982) whose registered office is at Unit 3, Chalkeymead Business Park, Bradford Road, Melksham, Wiltshire SN12 8LH ("Sensors");

(Osmetech, Molecular and Sensors are together the "Assignors")

- (4) Atlas Genetics Limited (company number 05513139) whose registered office is at 2 Temple Back East, Bristol, BS1 6EG (the "Assignee").

Background:

Pursuant to the provisions of the Shareholders' Agreement (as described more particularly below) the Assignors (Molecular [and Sensors] being wholly owned subsidiaries of Osmetech) wish to assign to the Assignee all intellectual property created by each of the Assignors within the Field.

It is agreed as follows:

1. Definitions and interpretation

In this Agreement, unless the context otherwise requires, the following definitions shall apply:

"Agreement" means this Agreement (including any schedule or annexure to it and any document in agreed form);

"Field" means the use of nucleic acids (including but not limited to the preparation/extraction, chemical modification, amplification or detection, or quantification of nucleic acids or derivatives thereof) solely for the development of electrochemical assays for meningitis and Chlamydia.

"Intellectual Property" means any and all intellectual property rights of any nature created by the Assignors within the Field which are capable of ownership (including without limitation trade marks and service marks, rights in know-how, patent rights (including any such rights in patents, copyright, design and design rights (both registered and unregistered), database rights, topography rights, inventions, processes or formulae, software or software code, ideas, research, trade secrets, work products, proprietary information, confidential information, and other intellectual or industrial property rights of any nature whatsoever);

"Shareholders' Agreement" means the Shareholders' Agreement relating to Atlas Genetics Limited between Quester Capital Management Limited in its capacity as general partner and manager of Sulis Seedcorn Fund Limited Partnership, Osmatech plc, The University of Bath, Laurie Peter, Toby Jenkins, Chris Frost, Stephen Flowers, Alison Kibble, Gordon Forest, John Clarkson, Karen Yates and Russ Keay dated of even date to this Agreement.

2. Assignment

2.1 In consideration of the provisions of the Shareholders' Agreement and the payment of £1 by the Assignee to each of the Assignors (receipt of which is hereby acknowledged) each of the Assignors assigns to the Assignee absolutely all its right, title and legal and beneficial interest in the Intellectual Property created by it within the Field together with all goodwill attaching to it, and statutory and common law rights and the right to sue for damages and other remedies in respect of any infringement of such rights and to retain any damages obtained as a result of such action together with the right to apply for prosecution and obtain any further applications and registration of the Intellectual Property in such forum as the Assignee deems fit or similar protection throughout the world with the intent that the grant of any resulting registration shall be in the name of and vest in the Assignee.

2.2 Further to the assignment of the Intellectual Property pursuant to clause 2.1, Molecular assigns to the Assignee absolutely with full title guarantee all its right, title and legal and beneficial interest in the Patents. The assignment effected by this clause 2.2 shall include, without limitation, the assignment and transfer of:

- (a) all patents that may be granted pursuant to any applications listed in Schedule 1, as well as all patents that may derive priority from or have equivalent claims to or be based on the Patents in any country in the world; and
- (b) all rights of action, powers and benefits arising from ownership of the Patents, including the right to sue for damages and other legal and equitable remedies (and retain any financial award made in any action) in respect of all causes of action arising prior to, on or after the date of this Agreement.

3. Warranties

3.1 Each of the Assignors warrants and represents to the Assignee that:

- (a) it has not entered into any agreement nor appointed any licensees of the Intellectual Property;
- (b) it has not made any other assignment or purported assignment of the Intellectual Property;
- (c) the Intellectual Property belongs to it absolutely and it is not aware of any claims, threats or actions by any third parties in relation to the Intellectual Property.

3.2 Molecular warrants, represents and undertakes that:

- (a) it is the sole applicant of the Patents;
- (b) it has not been and is not currently a party to any agreement or understanding which would in any manner be inconsistent with the assignment of the Patents provided for in this Agreement;
- (c) the applications in respect of the Patents are still subsisting; and
- (d) it has not granted any licences in respect of any of the rights in the Patents in any part of the world nor suffered any of them to be subject of any charge, mortgage or other encumbrance.

4. Further assurance

4.1 Each of the Assignors shall execute at the Assignee's expense any further documents that may reasonably be required by the Assignee:

- (a) to register the Assignee as proprietor of the Intellectual Property and the Patents;
- (b) to uphold the Assignee's rights in the Intellectual Property and the Patents;
- (c) to defeat any challenge to the validity of, and resolve any questions concerning, the Patents.

5. Entire agreement

5.1 This Agreement sets out the entire agreement and understanding between the parties in respect of the subject matter of this Agreement.

5.2 To the extent that any provision of this Agreement is found by any court or competent authority to be invalid, unlawful or unenforceable in any jurisdiction, that provision shall be deemed not to be a part of this Agreement. It shall not affect the enforceability of the remainder of this Agreement, nor shall it affect the validity, lawfulness or enforceability of that provision in any other jurisdiction.

5.3 Nothing in this Agreement shall create a partnership or joint venture between the Assignors and the Assignee, nor shall the Assignee have any authority to bind or commit the Assignors nor shall the Assignee be taken to have any authority to act as the Assignors' agent or in any other capacity.

5.4 Any written notice, invoice or other document which may be given by either party under the Agreement shall be deemed to have been given if left at, or sent by first class post or fax transmission (confirming the same by first class post) to, an address notified by the other party in writing as an address to which notices, invoices or other documents may be sent.

5.5 No variations of this Agreement shall be binding unless agreed in writing between the authorised representatives of the Assignors and the Assignee.

6. Governing law and jurisdiction

- 6.1 This Agreement shall be governed by and construed in accordance with English law.
- 6.2 Each of the parties irrevocably submits for all purposes in connection with this Agreement to the exclusive jurisdiction of the courts of England.

7. Exclusion of third party rights

Unless expressly provided in this Agreement, no term of this Agreement is enforceable pursuant to the Contracts (Rights of Third Parties) Act 1999 by any person who is not a party to it.

This Agreement has been signed on the date appearing at the head of page 1.

Schedule 1

Patents

1. International Publication Number: WO 03/074731 A2
International Patent Classification: C12Q 1/68
International Application Number: PCT/GB03/00613
Applicant: Molecular Sensing plc
International Filing Date: 11 February 2003
Title: Nucleic Acid Probes, Their Synthesis and Use
2. International Publication Number: WO 2005/005657 A1
International Patent Classification: C12Q 1/37
International Application Number: PCT/GB2004/002985
Applicant: Molecular Sensing plc
International Filing Date: 9 July 2004
Title: Protease Detection Assay

Signed by
for and on behalf of
Osmatech plc
in the presence of:

Signature of witness:

Name: NEIL SANGER

Address: 5 BERKELEY ROAD
CIRENCESTER
GLT 1TY

Occupation: COMPANY MANAGING DIRECTOR

Signed by
for and on behalf of
Molecular Sensing plc
in the presence of:

Signature of witness:

Name: NEIL SANGER

Address: 5 BERKELEY ROAD
CIRENCESTER
GLT 1TY

Occupation: COMPANY MANAGING DIRECTOR

Signed by
for and on behalf of
Molecular Sensors Limited
in the presence of:

Signature of witness:

Name: NEIL SANGER

Address: 5 BERKELEY ROAD
CIRENCESTER
GLT 1TY

Occupation: COMPANY MANAGING DIRECTOR

Signed by KAREN YATES
for and on behalf of
Atlas Genetics Limited
in the presence of:

Signature of witness:

Name:

Address:

Occupation:

LEENAGREEN

University of Bath

Claverton Drive

Bath

BA1 1RN



Companies House
— for the record —

287(ef)

**Change in situation or address of a
Registered Office**



XQCRKYEM

Company Name: ATLAS GENETICS LIMITED

Company Number: 05513139

Received for filing in Electronic Format on the: 28/03/2008

New Address Details

**New Address: 1 FRIARY
TEMPLE QUAY
BRISTOL
UNITED KINGDOM
BS1 6EA**

Please Note:

The change in the Registered Office does not take effect until the Registrar has registered this form. For 14 days, beginning with the date that a change of Registered Office is registered, a person may validly serve any document on the company at its previous Registered Office.

Authorisation

Authoriser Designation: director

Date Authorised: 28/03/2008

Authenticated: Yes (E/W)



United States Patent and Trademark Office

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Patent Assignment Abstract of Title

**NOTE: Results display only for issued patents and published applications.
For pending or abandoned applications please consult USPTO staff.**

Total Assignments: 2

Patent #: NONE

Issue Dt:

Application #: 10562290

Filing Dt: 06/20/2006

Publication #: 20060240503

Pub Dt: 10/26/2006

Inventors: Helen Braven, Russell Keay, Stephen Flower

Title: Protease detection assay

Assignment: 1

Reel/Frame: 023945/0001

Recorded: 02/12/2010

Pages: 10

Conveyance: CHANGE OF ADDRESS OF A REGISTERED OFFICE

Assignor: MOLECULAR SENSING PLC

Exec Dt: 09/16/2005

Assignee: ATLAS GENETICS LIMITED

1 FRIARY TEMPLE QUAY

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Correspondent: BELL & ASSOCIATES

MATTHEW KASER

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SAN FRANCISCO, CA 94127

Assignment: 2

Reel/Frame: 018445/0066

Recorded: 10/23/2006

Pages: 4

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignors: BRAVEN, HELEN

Exec Dt: 08/08/2006

KEAY, RUSSELL

Exec Dt: 08/08/2006

FLOWER, STEPHEN

Exec Dt: 08/07/2006

Assignee: ATLAS GENETICS, LTD.

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Correspondent: BELL & ASSOCIATES

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